

Remarks

In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

Claims 1, 36, and 55-57 have been canceled. Claims 37-38 and 93-94 remain pending.

The rejection of claims 57 and 94 under 35 U.S.C. § 101 for failing to sufficiently distinguish over cells that exist naturally is obviated in view of the cancellation of claim 57 and is respectfully traversed with regard to claim 94. It is the position of the U.S. Patent and Trademark Office (“PTO”) that the claimed host cells do not sufficiently distinguish over cells that exist naturally because the claims do not particularly point out any non-naturally occurring differences between the claimed product and the product of nature. Applicants respectfully disagree. In particular, claim 94 recites “[a] host cell comprising a heterologous DNA molecule according to claim 37” (emphasis added). Claim 37 recites “[a]n isolated DNA molecule ...” (emphasis added). Accordingly, claim 94 is limited to host cells comprising an isolated DNA molecule. Thus, this rejection is improper and should be withdrawn.

The rejection of claims 1, 37, and 55-57 under 35 U.S.C. § 112, second paragraph, for indefiniteness is obviated in view of the cancellation of claims 1 and 55-57 and is respectfully traversed with regard to claim 37. First, applicants note that the PTO has indicated that claim 37 is allowed on the Office Action Summary and page 12 of the outstanding office action. However, we provide the following comments with regard to claim 37. The PTO has asserted that the recitation of “the amino acid sequence comprising SEQ ID NO: 27 [sic]” is unclear. Applicants respectfully disagree. “The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” *Manual of Patent Examining Procedure* § 2173.02 (Rev. 6, September 2007) (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)). Applicants assert that one of ordinary skill in the art would clearly understand the scope of claim 37 as encompassing sequences that include SEQ ID NO:28 as set forth in the application. Therefore, this claim meets the threshold requirements of clarity and precision under 35 U.S.C. § 112, second paragraph. Furthermore, applicants note that the focus for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, “not whether more suitable language or modes of expression are available.” *Id.* As stated in MPEP §

2173.02, Examiners should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement. Accordingly, this rejection is improper and should be withdrawn.

The rejection of claims 1 and 55-57 under 35 U.S.C. § 112, first paragraph, for lack of written description is obviated in view of the above amendments canceling these claims.

The rejection of claims 1 and 55-57 under 35 U.S.C. § 112, first paragraph, for lack of enablement is obviated in view of the above amendments canceling these claims.

The rejection of claim 1 under 35 U.S.C. § 102(b) for anticipation by Pestova et al., *Mol. Microbiol.*, 21(4):853-862 (1996) or Cheng et al., *Mol. Microbiol.*, 23(4):683-692 (1997) is obviated in view of the above amendments canceling this claim.

The rejection of claims 1 and 36 under 35 U.S.C. § 102(a) for anticipation by PCT Publication No. WO98/42845-A1 to Ueyama et al. is obviated in view of the above amendments canceling these claims.

Finally, applicants note that the PTO has cited the following references on pages 2, 8, and 10 of the outstanding office action:

at page 2, paragraph 4: Bodnar et al., *J. Clin. Microbiol.* (1996) and Snyder et al., *Molecular Genetics of Bacteria*, American Society for Microbiology (1997);

at page 8, paragraph 11: Pestova et al., *Mol. Microbiol.*, 21(4):853-862 (1996), Cheng et al., *Mol. Microbiol.*, 23(4):683-692 (1997), and Genbank Accession No. AF000658; and

at page 10, paragraph 12: WO98/42845-A1 to Ueyama et al.

However, these references were not included in the PTO-892 form. Applicants respectfully request that the PTO provide a PTO-892 form listing the above references.

In view of all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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